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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,730	11/26/2003	Nicholas Frattalone	P25,565-A USA	7353

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EXAMINER

FELTEN, DANIEL S

ART UNIT PAPER NUMBER

3624

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/722,730

Applicant(s)

FRATTALONE, NICHOLAS

Examiner

Daniel S Felten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/26/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03/18/2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements (IDS) submitted on March 18, 2004 and March 31, 2004 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter. The invention in the body of the claim(s) must recite technology. If the invention in the body of the claim(s) is not tied to technological art, environment or machine, the claim is not statutory. The recitation in the body of the claims are directed identifying property and tendering property owners which do not show the use of technology because they are directed toward processes that can be performed by a person manually, and thus is considered nothing more than an abstract idea which is not a useful art as contemplated by the constitution [see *Ex Parte Bowman*, 61 US PQ2d 1665, 1671 (BD Pat. App & Inter 2001) (Unpub)]*. Also note MPEP 2106 IV 2(b). What is the technology used to carry out the invention? Does a computer carry out the method?

*Although *Bowman* is not precedential, it can be cited for its analysis.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A computer, which critical or essential to the practice of the invention within Business Methods, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The use of some technology (i.e. computer) is not shown in the specification or in the claims to enable the property and payment method.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1 et al, What is the criteria of a "suitable" property? What "scenarios and choices" are you referring to? In claim 5, what is meant by "if necessary"? What are the criteria/conditions in which it would not be necessary? In claim 5 et al, What meant by a

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“reasonable degree”? What are the criteria for liquidity to be considered a
“reasonable degree”?

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for
all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable
over SBA Communications Corporation Announces 2nd Quarter Results;
Accelerates Tower Ownership (Aug 14, 1998) and SBA website (sbsite.com).

Claims 5-25, disclose various terms regarding portions of land to be
leased (5-6), the period of payment (7-9), payment type (11-15), right of first
refusal (16-25).

In typical property leasing agreements/ purchase offers between tenants
and landowners, terms and conditions (such as payment type, period of
payment, length of the lease—term, terms of lease renewal, lease to own
conditions, right of first refusal terms, etc,) may be negotiated. Conventionally
lease costs are paid in periodic payments over the term of the lease with
potential Lump sum payments on the front, back end and credits and/or penalties

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are added/subtracted to the lessee's regular payment based upon the terms of the leasing agreement/offer.

SBA provides communication site services to the wireless communication community. Such services, as in claims 1-4, include, a broad array of *site acquisition*, zoning, construction and *tower space leasing services* (see paragraph 4).

Since SBA provides a broad array of site acquisition, zoning, construction and leasing services which are negotiated and tailored to their needs and that of their clients, it would have been obvious for an artisan of ordinary skill in the art to recognize that SBA would be able to accommodate their client's needs by providing various negotiable leasing scenarios and choices (Terms). Thus being able to negotiate terms and conditions as well as tailor themselves to the needs of their clients, one of ordinary skill in the art would recognize SBA's flexibility to adapt to the ever changing wireless communication community as well as provide the ability to service a broader customer base over longer periods of time. Thus flexibility in terms of site acquisition and leasing service creation, would be considered necessary to remain solvent in the highly competitive wireless market, and thus have been considered an obvious expedient well within the ordinary skill in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S Felten whose telephone number is (703) 305-0724. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DSF
August 12, 2004



Daniel S Felten
Examiner
Art Unit 3624

**VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**